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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

CARLSON, JEFFREY D

ART UNIT PAPER NUMBER

3622

DATE MAILED: 10/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/943,941

Applicant(s)

PROROCK, THOMAS JOSEPH

Examiner

Jeffrey D. Carlson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 July 2004.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 9-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 9-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is responsive to the paper(s) filed 7/1/04.

Claim Objections

2. Claims 2 and 11 are objected to because of the following informalities:
 - Claim 2 line 9, claim 11 line 9, --to—should be inserted after “related” for clarity.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 1-4, 9-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sloane (US5918211) in view of Harms et al (US6070147).**
5. Regarding claims 1, 2, 10, 11, Sloane teaches a handheld scanner which is used to scan a user's card to determine the users identity [3:32-41]. This is sent wirelessly to a remote host which looks up and transmits the user's account information to the display on the scanner. The scanner provides the status of the user's account such as available discounts, *credits*, rewards, etc stored in their account [9:5-20]. The scanner provides a running total and information regarding the current purchases as well as

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year-to-date savings [3:65-66]. As the user scans products throughout the store, the scanner will identify the products and their prices and will alert the user when a certain product is eligible for a promotion [3:12-23]. The customer is also alerted at the scanner device to available discounts, *credits*, *rewards* or promotions [3:39-41]. The user can use the scanner buttons to add the product to his current product total [6:21-28]. The user can also display the current running balance on the products purchased [6:36-38]. Harms et al teaches the idea of accruing points by shopping and getting an award *at a particular plateau* for the loyalty point balance [fig 8a]. It would have been obvious to one of ordinary skill at the time of the invention for the host to have kept a running total of the loyalty points earned during the shopping trip and combined them with the credits previously earned so that the user is made aware of his current running loyalty balance much like Sloane's desire for notification of updated current+stored purchase information. It would have been obvious to one of ordinary skill at the time of the invention to have let the users know the plateau values (and optionally their current shortage), so that they are encouraged to make purchases in order to achieve the plateau. Such information (current balance and plateau value(s) and optionally their shortage) serves to alert the users when they are within various thresholds/ranges from the predetermined plateaus as well as when they have reached the plateau.

6. Regarding claims 3, 4, 12, 13, Sloane teaches that the user can press a button to confirm the purchase of a scanned product [6:26-28]. The host cannot provide updated real-time balances (purchases, purchase amounts, loyalty balances) until the host is

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made aware of the current scanned purchase which does not occur until the user confirms the purchase.

7. Regarding claims 9, 14, the device is portable.

Response to Arguments

8. Applicant argues differences between Sloane and Harms et al. First - that Harms et al is not really directed to the idea of accruing points by shopping and getting an award, but rather collecting consumer information for marketing purposes. Clearly Harms et al's teaches earning points by shopping and earning rewards at various point level plateaus. What Harms et al chooses to do with collected information is not terribly relevant to the rejection proposed. Second – that Harms et al does not influence purchases at the point of purchase. This is clearly taught by the base reference, Sloane which is modified by Harms et al; Harms et al need not include such a feature. Lastly, Sloane and Harms et al use different types of cards to identify the user. Nothing regarding any card is required by the claims and any difference between the cards proposed have no particular bearing on the proposed rejection. The two references are strongly related to applicant's field of endeavor and are suitable for a 103 combination.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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- Stevens (US6327570) [col 18] teaches a portable communications device that keeps track of the shopper's loyalty point balances and purchases by sending and receiving real-time updates to a host. The unit also alerts the user when they earn particular rewards.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 703-308-3402. The examiner can normally be reached on Mon-Fri 8:30-6p, (off on alternate Fridays).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on 703-305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jeffrey D. Carlson
Primary Examiner
Art Unit 3622

jdc